

REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the Final Office Action dated September 1, 2009 and has carefully reviewed its contents. In the Office Action, the only pending rejection is a provisional non-statutory double patenting rejection of claims 22-47 of the present application over claims 1-49 of co-owned and co-pending Patent Application No. 10/374,751 ("the '751 Application").

As outlined in the Manual of Patent Examining Procedure (M.P.E.P.), the analysis in an obviousness-type double patenting rejection parallels the factual inquiries set forth for determining obviousness under 35 U.S.C. § 103(a). M.P.E.P. 804, II, B. 1. (8th Ed., Rev. 7). The M.P.E.P. sets forth clear guidance as to when a non-statutory double patenting rejection is appropriate. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s)." M.P.E.P. 804 (citations omitted)(emphasis added).

According to the M.P.E.P. "analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination." *Id.* Furthermore, the M.P.E.P. continues:

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application;
and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention defined in a claim in the patent.

With respect to (A), the Office Action skirts the difference in scope provided by the element “wherein said first groove has a width less than about 1 mm” by asserting that this feature is an “obvious design choice”. The law governing “design choice” refers to rearrangement of parts, not as to structural limitations such as the width of a feature. See M.P.E.P. 2144.04. In the present application, the Office Action has offered no reasons why this limitation would have been either (a) obvious in view of the claims of the co-pending application or (b) could be ignored as an element of the claim.

With respect to (B), the Office Action has provided no reasons why one of ordinary skill in the art would conclude that the invention defined in the claim at issue would have been an obvious variation of the invention of any of the claims of the ‘751 application.

Furthermore, the claims of the ‘751 application were further amended by submission on February 19, 2010, further rendering the present Obviousness-Type double patenting rejection moot.

As the Final Office Action has failed to meet the requirements of an obviousness double patenting rejection, Applicants believe that the filing of a Terminal Disclaimer is premature.

Applicants respectfully request withdrawal of the Obviousness-Type double patenting rejection and requests that this application be passed to issuance. In view of the foregoing Remarks, Applicants believe the application is in condition for allowance and early, favorable action is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Respectfully submitted,

Dated: February 26, 2010

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